

REMARKS/ARGUMENTS

Applicant has studied the Office Action of April 7, 2005 and made amendments to the specification and claims, as indicated hereinabove, to place the application in condition for allowance. No new matter has been added.

Claims 1 - 3 have been cancelled without prejudice to filing future continuation application(s). Claim 4 has been amended to define Applicant's invention over the cited prior art. Claims 5 - 20 have been cancelled without prejudice to filing future continuation application(s). New claims 21 - 32 have been added, as indicated hereinabove. Therefore, claims 4 and 21 - 32 are presently pending.

Drawing Objections Under 37 C.F.R. 1.84(p)(5)

The drawings have been objected to as failing to comply with 37 C.F.R. 1.84(p)(5). Specifically, reference numeral 82 of Fig. 11 is not mentioned in the specification. Also, reference numeral 80 of Fig. 11 points to a helmet surface, yet the specification refers to reference numeral 80 as nuts.

Applicant has amended the specification instead of the drawings, as indicated hereinabove, to designate reference numeral 80 of Fig. 11 as referring to a helmet surface, and to designate reference numeral 82 of Fig. 11 as referring to nuts. Applicant believes that these amendments to the specification place the drawings in compliance with 37 C.F.R. 1.84(p)(5).

Claim Rejections Under 35 U.S.C. §102

Claims 1, 4 - 5 stand rejected under 35 U.S.C. §102(b) as being anticipated by Prupis (U.S. Patent 2,640,980). Prupis discloses an illuminated head covering containing a base plate 10 mounted on the crown of a hat via rivets 12 (Fig. 2). Base plate 10 is covered by a translucent dome 16. A light bulb 32 is centered on base plate 10 and positioned with its filament above the upper edge of the base. Light bulb 32 is powered by a battery 40 which is carried in a user's pocket (Fig. 1).

The Examiner asserts that Prupis discloses Applicant's invention, as originally claimed. Applicant respectfully submits that the invention, as presently claimed, is patentably different from the illuminated head covering of Prupis. Specifically, there is no teaching in Prupis in regard to a base having at least one prong adapted to mate with at least one aperture (on a crown interface portion of a first housing) such that a portion of the prong extends away from the crown portion after mating, and the extending prong portion is bent toward the crown portion by at least one power source to secure the first housing to the crown portion as the power source is being pushed in the first housing, as recited in amended claim 4.

Prupis teaches away from the presently claimed invention by reciting a base plate 10 being "mounted on crown of the hat and secured thereto as by rivets 12," Col. 2, lines 10 - 12, Fig. 2. Prupis fails to recite a base equipped with at least one prong adapted to mate with at least one aperture on a crown interface portion of a first housing such that a portion of the prong extends away from the crown portion after

ming, as presently claimed by Applicant. Prupis also teaches away from the presently claimed invention by reciting a light bulb battery 40 that is carried in a user's pocket (Fig. 1), rather than being received within a first illuminating device housing, as presently claimed by Applicant. Furthermore, cord 42 of Prupis "leads from the battery under the hat brim and has one lead 44 connecting with socket 30 and another lead 46 connecting with blinker 48," Col. 2, lines 43 - 46, Figs. 1 - 2.

Applicant respectfully submits that for a reference, such as the Prupis reference, to function under 35 U.S.C. §102(b), the reference must within the four corners of that document disclose each and every element that is set forth in the claim against which it is applied. Furthermore, every element of the claimed invention, as recited in the claims, must be disclosed either specifically or inherently by a single prior art reference. See, *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed.Cir.1992); *Scripps*, 927 F.2d at 1576-77; *Lindemann Maschinenfabrik GMBH, v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed.Cir.1984).

Clearly, the Prupis reference does not anticipate in any way Applicant's invention, as recited in amended claim 4. Applicant respectfully requests withdrawal of the 102(b) claim rejections in regard to that claim. Claims 1 and 5 have been canceled, as indicated hereinabove, rendering the Examiner's rejections thereto moot.

Claims 1 - 3 and 6 - 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by Rodriguez et al (U.S. Patent 6,244,721). Claims 1 - 3 and 6 - 7 have been canceled, as indicated hereinabove, rendering the Examiner's rejections thereto moot.

Claims 1 and 9 - 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by Johnston (U.S. Patent 4,186,429). Claims 1 and 9 - 15 have been canceled, as indicated hereinabove, rendering the Examiner's rejections thereto moot.

Claims 1, 8 and 16 - 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by Sinclair et al (U.S. Patent 3,358,137). Claims 1, 8 and 16 - 20 have been canceled, as indicated hereinabove, rendering the Examiner's rejections thereto moot.

In view of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the 102(b) claim rejections.

The claims as amended are not and could not be anticipated by the applied references. Further, the Examiner is requested to reconsider his rejection of Applicant's invention in view of the prior art. The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an Applicant's invention on the basis of the Applicant's total disclosure. In the present case, there is no disclosure or suggestion in the Prupis patent relied on by the Examiner from which the invention claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner would be unable to reconstruct, from the cited references, an invention which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an Applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and
- (2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicant. None of the references, alone or in combination, disclose or suggest that combination of elements recited in Applicant's present claims. As such, Applicant's claims all go beyond that which has been

achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. The Examiner has unsuccessfully tried to cull from the cited references specific elements claimed by Applicant, based on Applicant's own teaching and not on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entireties, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence

of obviousness as qualified in 35 U.S.C. §103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of Prupis or the other references of record. The amended claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the Applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the Applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). What the Examiner is

attempting is a piecemeal construction of the prior art in view of the Applicant's own disclosure in order to negate the present invention. The law clearly does not sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art . . . "

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an Applicant's invention on the basis of the Applicant's total disclosure. There is no teaching or suggestion in either the Prupis or other references relied on or cited by the Examiner from which the invention claimed by Applicant can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which

supports selection and use of the various elements in particular claimed combination. . . It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ2d 1614 is even more direct. In this case the Applicant sought a patent for a large trash bag decorated with lines and features so that when filled it resembled a Halloween-style pumpkin or jack-o'-lantern.

The prior art showed large trash bags and an activity book showing how to make paper bag pumpkins and jack-o'-lanterns. The CAFC reversed the Board's finding of obviousness stating:

"Because we do not discern any finding by the Board that there was a suggestion, teaching or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand."

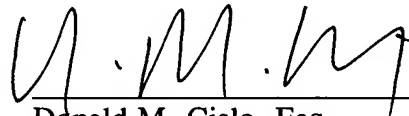
Conclusion

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Applicant believes that the claimed invention, as amended, is in condition for allowance. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the telephone number listed herein below to discuss any steps necessary to place the application in condition for allowance.

In the event that any fees are due, the Examiner is authorized to charge our USPTO Deposit Account # 03-2030. A duplicate of this authorization is enclosed.

Respectfully submitted,

CISLO & THOMAS LLP



Donald M. Cislo, Esq.
Reg. No. 22,060

Date: April 26, 2005

DMC/MM:cjh

Enclosures:

Acknowledgement Postcard

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401
Tel: (310) 451-0647
Fax: (310) 394-4477
www.cislo.com

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed as follows:

Mail Stop AMENDMENT
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

on 4-26-05
Donald M. Cislo, Reg. No. 22,060 4-26-05
Date